

Appl. No. 10/631,794

Amdt. dated July 7, 2008

Reply to Office Action of May 14, 2008

Remarks/Arguments:

Amendments to Specification

Paragraphs [0044] and [0046], on page 6 of the specification, have been amended to refer to reference numeral 13' rather than 13, for consistency with Figure 5 (amended September 12, 2007).

Claim Amendments

Claims 1 – 3, 6 and 11 – 18 have been cancelled to reduce the issues.

Claim Rejections – 35 USC § 101

Claim 1 is rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter.

Claim 1 has been cancelled thereby rendering moot Examiner's rejection under 35 U.S.C. 101.

Claim Rejections – 35 USC § 102

Claims 1 – 8 and 11 – 12 are rejected under 35 U.S.C. 102(e) as being unpatentable having regard to US 6,697,840 (Godefroid et al).

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As indicated above, claims 1 – 3, 6, 11 and 12 have been cancelled. Accordingly, Examiner's rejection of claims 1 – 3, 6, 11 and 12 under 35 U.S.C. 102(e) is rendered moot.

Claim 4 has been re-written into independent form including the limitations of base claim 1 and intervening claims 2 and 3.

Having regard to claim 4, Examiner states that Godefroid et al teaches a system as claimed in claim 3, "wherein said role-based subscription request identifies said Presentity and includes a role definition therefore (column 2, lines 51 – 65).

The passage cited by the Examiner reads as follows:

"From the users' point of view, there is a fundamental tradeoff between access to presence data for legitimate uses, and concerns about privacy. Precisely to the extent that a user A is able to identify what another user B is doing, user A can communicate with user B when the need arises, make his/her communications more timely and convenient for user B, and generally be a more effective colleague, or more accessible or responsive friend or family member. This is the sort of information, however, that users would generally not like to provide to strangers, nor perhaps to managers, competitors, or friends and family members. Moreover, the data are largely generated automatically and potentially quite frequently, so users cannot be expected to monitor all presence events in order to ensure appropriate levels of privacy."

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As Examiner is aware, to anticipate an invention, a prior art reference "must disclose each and every feature of the claimed invention, either explicitly or inherently" (*Eli Lilly v. Zenith Goldline* (Fed. Cir. 2006), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Otrhopaedics, Inc.* (Fed. Cir. 1992)). "Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claims limitations, it anticipates" (*in re Crucifrouse Sprout Ltig.*, (Fed. Cir. 2002)). Also, "In general, a limitation or the entire invention is inherent and in the public domain if it is the 'natural result flowing from' the explicit disclosure of the prior art", (*Schering*, (Fed. Cir. 2003), citing *Eli Lilly & Co. v. Barr Labs, Inc.* (Fed. Cir. 2001); *In re Katz* (CCPA 1979)).

It is clear from the passage cited by the Examiner that Godefroy fails to explicitly disclose either the claimed "role-based subscription request" or the claimed "role definition", as recited in claim 4. Also, there is no indication in Godefroy that it necessarily functions in accordance with the claimed "role-based subscription request" or the claimed "role definition". Finally, there is no suggestion that the claimed "role-based subscription request" or the claimed "role definition" are the 'natural result flowing from' the explicit disclosure of Godefroy.

Claim 7 has been re-written into independent form including the limitations of base claim 1 and intervening claims 2 and 6.

Having regard to claim 7, Examiner states that Godefroid et al teaches a system as claimed in claim 6, "wherein said role-based subscription request identifies said Presentity and includes a role definition therefore (column 6, lines 33 – 44)".

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The passage cited by the Examiner reads as follows:

“To economize, one often defines implicit rules and explicit rules instead. For example, the implicit rule is, when the door of a user say X is open, in general, any other users can send X an invitation to join a collaborative session; and when X's door is closed, in general, nobody can send X the invitation. To explicitly exclude a user say j from sending an invitation to user i even if i's door is open, the following exception rule can be set door $\langle i \rangle$ (open) – invite $\langle j \rangle$ ”

And to explicitly grant j the permission to invite i even if i's door is closed, the exception rule can be set door $\langle i \rangle$ (closed) – invite $\langle j \rangle$ ”

It is clear from the passage cited by the Examiner that Godefroy fails to explicitly disclose either the claimed “role-based subscription request” or the claimed “role definition”, as recited in claim 7. Also, there is no indication in Godefroy that it necessarily functions in accordance with the claimed “role-based subscription request” or the claimed “role definition”. Finally, there is no suggestion that the claimed “role-based subscription request” or the claimed “role definition” are the ‘natural result flowing from’ the explicit disclosure of Godefroy.

Examiner specifically indicates that the “implicit rules” of Godefroy are the equivalent of a “role definition”. With respect, a “rule” is not a “role”. Even the broadest possible interpretation of Applicant’s claimed “role” does not include a “rule”. The term, “role”, is used in Applicant’s specification and claims in accordance with its ordinary

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every day meaning, that is: "(1): a character assigned or assumed <had to take on the role of both father and mother (2): a socially expected behavior pattern usually determined by an individual's status in a particular society" (Merriam-Webster Dictionary). For example, paragraph [0033] of the specification refers to a Presentity controlling his/her availability in the particular *role* of "Nurse", and in paragraph [0068] "a teacher can be in a *teaching role* when in class and can therefore be available to particular persons from that class. Similarly, in medical applications *doctors can take on particular roles in a hospital*" (emphasis added).

Likewise, in Godefroy, the term "rule" is used in accordance with its ordinary every day meaning, that is "a prescribed guide for conduct or action" (Merriam-Webster Dictionary). For example, in the passage cited by the Examiner, "the implicit rule is, when the door of a user ...X is open, ... any other users can send X an invitation to join a collaborative session; and when X's door is closed...nobody can send X the invitation".

In as much as a "rule" is not a "role", the implicit and explicit "rules" of Godefroy do not teach or suggest the particular "roles" that may be assumed by a Presentity, and the cited passage of Godefroy accordingly fails to disclose "wherein said role-based subscription request identifies said Presentity and includes a role definition therefore".

Retraction of Examiner's rejection of claims 4 and 7 under 35 U.S.C. 102(e) is respectfully requested.

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Claim Rejections – 35 USC § 103

Claims 9 and 13 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godefroid et al in view of US 6,735,716 (Rowstowfske et al).

As indicated above, claims 9 and 13 – 18 have been cancelled. Accordingly, Examiner's rejection of claims 1 – 3, 6, 11 and 12 under 35 U.S.C. 102(e) is rendered moot.

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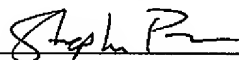
CONCLUSIONS

Applicant believes that this application is now in condition for allowance. To the extent that any issues remain to be resolved, however, applicant requests that the Examiner contact the undersigned to resolve these issues.

The Commissioner is authorized to charge the extension of time fees to the Credit Card as shown in the Credit Card Payment Form.

The Commissioner is also authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 502721.

Respectfully submitted,



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July 7, 2008
(date)